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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,603	01/24/2002	Hideki Ito	9333/284	2928
7590	03/24/2006			
Brinks Hofer Gilson & Lione P.O. Box 10395 Chicago, IL 60610			EXAMINER DINH, TAN X	
			ART UNIT 2627	PAPER NUMBER

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/057,603	<b>Applicant(s)</b> ITO, HIDEKI	
	<b>Examiner</b> TAN X. DINH	<b>Art Unit</b> 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3,4 and 7-9 is/are allowed.
- 6) ☒ Claim(s) 11-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1) A Request for Continued Examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/12/2006 has been entered.

2) The preliminary amendment filed 1/12/2006 is acknowledged. Claims 2,5,6,10 and 14 have been canceled.

3) Claims 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "can be" ( claim 11, line 12 ) render(s) the claim(s) indefinite. The phrase "can be" has two meanings which indicates that the session can be manually selected and not be manually selected. That would make the resulting claim(s) do not clearly set forth the metes and bounds of the patent protection desired.

Claim(s) 12 incorporate the indefiniteness of claim(s) 11 by virtue of their dependency thereon.

4) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5) Claims 11-13 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over KELLER et al ( 6,587,404 ).

KELLER et al discloses an audio device and method for managing track files as claimed in claims 11 and 12, comprising a display ( Fig.4, display 46; Fig.7, display device 46 on front bezel 44 ), a read out unit for reading out track files recorded on a recordable medium ( Fig.4, audio track files are read out from data storage structure 106 ), wherein the recordable medium contains at least one session and a session is automatically formed each time writing is performed and includes one or more track files ( plurality of sessions are inherent in every recordable optical disk ( CD-R, DVD-R, DVD-RW, etc.,) and a session is automatically formed each time

the writing is performed ( it is noted that, one session is formed at the time of writing, if the writing stop which indicated the last session is end and when the recording restart, a new session is formed, the session includes one or more track files. The sessions are well known in optical recordable disk, which is shown in ITO et al (US 6,243,340), figure 4; ITO et al (US 6,631,107), figure 2; MURATA et al, (US 6,621,783), figure 5; MISAIZU (US 6,594,214), figure 5; HASHIMOTO (US 6,370,096), figure 4 and MURATA (US 6,363,040), figure 4. If the recordable disk is not completely record, each time recording new track files which forms a new session, this process is continued until the recordable disk is completely recorded ), a controller which manages the track files recorded on the recordable medium in each session and which displays the session containing the file of an arbitrary track on the display ( Fig.4, CPU 94; Fig.7, display 46 displays session 200 containing the file of an arbitrary track. See also column 15, line 1 to column 16, line 59 ), wherein the controller regards each session as a virtual disk, allocates a track number for each of the track files in each session and display a name of the virtual disk corresponding to the session containing the file of the arbitrary track on the display, the track number and a name of the track ( Fig.7, name of virtual disk is "METALLICA ", figure 8, the tracks number of the tracks are "1", "2", "3" and "4" and

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name of the tracks (songs) are " Fade To Black ", " King Nothing ", " Sad But True " and " Fuel " ) and the sessions can be selected manually by a user by operating the next-disk key or previous-disk key ( Since the disk of KELLER et al is partitioned into a plurality of sessions (or virtual disk) as seen in figures 7-22, the keys for accessing to each sessions (or virtual disk) are inherent in KELLER et al's audio player ), except to specifically show that (i) recordable medium is optical disk (CD-R) and (ii) playing back the track files recorded at latest (oldest) session to newest session. It would have been obvious to someone within the level of skill in the art at the time of the invention was made to substitute optical recordable disk in KELLER et al for the disclosed magnetic disk and playing back the track files in oldest session to newest session fashion as claimed. The rationale is as follows:

a) Optical recordable disk (CD-R) is known in the recording art to be equivalent to magnetic disk for storing information data ( both of them capable of recording or storing information data ) and,

b) It has been well known and generally recognized in the art that any parts or songs recorded on CD or any recordable medium are capable of playing back at any directions, any sequences, randomly or selected as play-list ( these features are inherent in every optical disk player, which also shows in KELLER et al's figure 2,

manually control keys 43,45,47,49,50 ). Therefore, one of ordinary skill in the art at the time of the invention was made would have been motivated to replace an optical recordable disk in KELLER et al's disk player and playing back the tracks recorded in session at any desirable directions (latest to newest or newest to oldest) as claimed.

Method claims 13 and 15 are drawn to the method of using the corresponding apparatus claimed in claims 11 and 12. Therefore, the method claims are rejected for the same reasons of obviousness as used above.

As to claims 16 and 17, KELLER et al shows the track files is compressed by MP-3 format ( column 21, line 50 to column 22, line 7. It is noted that, TOC (management information) is inherent in every CD-ROM disk ).

As to claim 18, it would have been obvious to display the track name of latest session when the signal is read from the recordable medium as claimed since the track names in recordable disk can be displayed at any suitable manner based on the command input from the users.

As to claim 19, it would have been obvious to playback first track corresponding to the displayed name when a predetermined key is operated in a state in which the latest session is displayed as

claimed since the recorded tracks in any audio player (CD player) can be selectively played at any desirable directions (first track, last track, middle track, etc., ).

As to claim 20, it would have been obvious to sequence play back track from one session to another session since this technique is old and well known in optical reproducing art.

6) Claims 1,3,4,7-9 are allowed.

7) Applicant's arguments filed 1/12/2006 have been fully considered but they are not persuasive.

First, the feature of allocating track files in each session in order of time of recording is inherent in every sessions recording method as applicant states in the specification, page 1 of the "related art ", each track is managed on the basic of file name and timestamp, during playback process, the player playback in order from the oldest timestamp track to newest timestamp track or vice versa. This technique is old and widely used in the recording art.

Second, claim 11 using the phrase " can be " which does not always manually selecting the sessions. Further, the disk of KELER et al is partitioned into a plurality of sessions (or virtual disk) as seen in figures 7-22, the keys for accessing to each sessions (or



virtual disk) must be included in order to select the desire session for reproducing.

For those reasons, the claims 11-13 *and* 15-20 are still rejectable as shown above.

8) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

HORIE (6,671,249) discloses an optical recording medium wherein the audio information are stored on sessions and each session is considered as virtual disk.

( see form PTO-892 attached herein ).

Applicant is reminded that in amending in response to a rejection of claims ( if the rejection involves with any applicable arts ) the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant *must also show how the amendments avoid such references and objections.* See 37 CFR § 1.111(c).

9) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN Xuan DINH whose telephone number is (571) 727-7586. The examiner can normally be reached on MONDAY to FRIDAY from 8:00AM to 5:30PM.

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The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**TAN DINH**  
**PRIMARY EXAMINER**

March 22, 2006